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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2625

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/964,257

Applicant(s)

TERASHIMA ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-10, 19-25, 34-36, 38-50 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10, 19-25, 34-36, 38-50 and 52-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/11, 1/12, 1/31/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed April 18, 2006 have been fully considered but they are not persuasive.

- a. For claim 7, applicant remarks that the second sheet-transporting path (5) is not defined "by a scanner apparatus and a base apparatus" when the scanner is mounted on the base apparatus.

It is noted that in Figs.1, 2, 3 and 5, Tajima teaches that path (5) is defined by the scanner 2 and the base apparatus 6. For instance, Fig. 5 clearly shows that the path 5 is defined by a surface of the scanner 2 on which the reading element is provided and a surface of the base apparatus 6 which faces the scanner 2 in a case where the scanner 2 is mounted on the base 6.

- b. For claim 10, applicant remarks that both of Tajima and Shimizu do not have any groove, which receives a protecting member, which is for protecting a pick roller. The groove in Fig.3 of Shimizu is not the groove, which receives the protecting member.

Although Shimizu does not directly mention a groove that can receive a protecting member, Figs. 3 and 4 can show a groove that can receive a protecting member of the scanner 200 and that is provided in the surface of the base apparatus 100 facing toward the scanner. If the applicant does not agree that it is the claimed groove in the claim, clarification of the groove claimed in claim 10 is needed.

- c. For claims 19 and 46, applicant remarks that both Tajima and Shimizu do not suggest that the hand scanner rotates frontward by the pivotal shaft.

It is noted that a pivotal shaft for allowing a part to rotate frontward while the other part is in the form of a holding member for holding the pivotal shaft is a matter of well known in the art. Although Shimizu does not directly teach a pivotal shaft but it is a matter of design choice to add a pivotal shaft, Shimizu discloses an engaging portion to allow the scanner apparatus to rotate frontward while the other is in the form of a holding member. Submitted reference Miller et al (US Patent No.5, 331,580) support that well known prior art of a pivotal shaft shown in Fig.11 (col. 17, lines 25-33) and submitted reference Taniguchi et al (US Patent No. 6,064,498) discloses the use of a pivotal shaft in Figs. 3-4 (col. 3, lines 14-30; col. 3, line 62 – col. 4, line 3). Thus the presence of the claimed pivotal shaft does not render the claim patentable.

d. Regarding claim 24, applicant remarks that both Tajima and Shimizu do not disclose a space between two sheet guides become gradually narrower toward a sheet withdrawal port and an offset member.

Fig.4 in Shimizu shows that the angle between the 2 sheet guides is less than 90 degrees, thus the space between them become gradually narrower. Also, in Fig. 4, Shimizu discloses on sheet guide on tray 100c having an offset member as shown in Fig.9 of the invention.

e. Applicant remarks that both Tajima and Shimizu do not disclose that the first and second sheet guides are formed on the up stream.

Figs. 1, 2, 5 of Tajima show that the sheet guides 5 and 3a are formed on the up stream.

f. For the remaining remarks, applicant attacks references individually in a 103 rejection where two references Tajima and Shimizu are combined. Applicant cannot show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. In re Keller, 208 USPQ 871 (CCPA 1981). In addition, applicant

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remarks that the secondary reference Shimizu cannot be bodily incorporated into the primary reference Tajima. It is noted that the test of obviousness is not whether the features of the reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art. In re Bozek, 163 USPQ 545, (CCPA 1969); In re Richman 165 USPQ 509, (CCPA 1970); In re Beckum, 169 USPQ 47 (CCPA 1971); In re Sneed, 710 F.2d 1544, 218 USPQ 385. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. In re Sheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968).

In addition for the well-known prior art issues or a structure that is “old and well known in the art”, applicant is requested to review the previous submitted and cited references if applicant does not agree with the teaching of Tajima in view of Shimizu in the rejection. For instance, Minoru reference (Japanese Patent No. 8163288), Kojima (US Patent No. 5,412,490), Tanoue et al (US Patent No. 5,884,117), Saito (European Publication Number 0587316A1), Minoru (Japanese Publication number 08051520).

The rejection of the claims is maintained.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima (Japanese Patent No. JP403003030A).

Concerning claim 7, Tajima discloses an apparatus (Fig.1) comprising a base apparatus (3) which includes first sheet transporting path (3a) extending substantially vertically and perform a first processing for a sheet traveling downward along all length of the first sheet transporting path; and a scanner apparatus (2) which can be removable mounted on the base apparatus and includes a reading element (Fig.5); wherein a second sheet transporting path (5) extending substantially vertically is defined by a surface of the scanner apparatus on which the reading element is provided, and a surface of the base apparatus which faces to the scanner apparatus in case where the scanner apparatus is mounted on the base apparatus (Fig.2), and a second sheet travels downward along all length of the second transporting path; and wherein the scanner apparatus (Fig.5) includes a pick roller (20) provided at a location upstream of the second sheet transporting path and viewed in a sheet transporting direction and includes a feed roller (21) provided at locations downstream of the second sheet transporting path, the first and second sheet transporting paths being provided along and adjacent and nearly parallel to each other at their straight guide parts of the upper portion, and the first and second sheet delivery ports are provided at a same side of the apparatus (Figs.1-2); and wherein the scanner apparatus is so implemented as to be capable of operating as a hand scanner is a case where the scanner apparatus is detached from the base apparatus (Abstract).

Concerning claims 8-9, Tajima further teaches the scanner apparatus has a protecting member to provided in a manner projecting at a side of the surface of the scanner apparatus, to protect the pick roller from collapsing with the weight of the scanner apparatus in a case where

the scanner apparatus is used as a hand scanner and the protecting member is provided at a location outside of a reading area of the scanner apparatus (claims 8-9), (Figs.1, 5).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima as applied to claim 7 above, and further in view of Shimizu (US Patent No. 5,663,811).

Concerning claim 10, Tajima fails to teach a groove to receive the protecting member is a case where the scanner apparatus is mounted on the base apparatus is provided in the surface of the base apparatus facing toward the protecting member. However, it is a matter of well known in the art at the time the invention was made to have a groove in Tajima to better hold the hand scanner mounted on the base apparatus. Shimizu supports the well-known prior art by teaching a hand-held scanner mounted on a base apparatus having the groove to receive and hold the hand-held scanner (Fig.3). It would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the art supported by Shimizu to have a groove on the surface of the base apparatus facing toward the protecting member in order to hold the scanning part 2 since Tajima teaches that the scanner part 2 is attachable/detachable fitted on the recessed part 3 while does not limit any supporting mechanism for holding the scanning part 2.

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5. Claims 19-25, 34-36, 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima in view of Shimizu (US Patent No. 5,663,811).

Concerning claims 19, 46, Tajima discloses the apparatus as discussed in claim 7 above.

Tajima fails to teach an engaging portion and a scanner mounting portion wherein either of them is a pivotal shaft for allowing the scanner apparatus to rotate frontward while the other is in the form of a holding member for holding the pivotal shaft. However, it is a matter of old well known in the art at the time the invention was made to have a structure with a pivotal shaft in Tajima to better hold the hand scanner mounted on the base apparatus since a pivotal shaft for allowing any device to rotate frontward while a mounting portion is in the form of a holding member for holding the pivotal shaft has been known. In addition, it is a matter of design choice and old structure to have an engaging portion to engage any device on a mounting portion. Shimizu supports the well known prior art by teaching a hand-held scanner mounted on a base apparatus having an engaging portion to allow the scanner apparatus to rotate frontward while the other is in the form of a holding member for holding the pivotal shaft receive and hold the hand-held scanner (Figs.1, 5). It would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the art and a matter of design choice, supported by Shimizu to use a pivotal shaft for allowing a scanning apparatus to rotate frontward while the mounting portion is in the form of a holding member for holding the pivotal shaft since Tajima teaches that the scanner part 2 is attachable/detachable fitted on the recessed part 3 while does not limit any supporting mechanism for holding the scanning part 2.



Concerning claims 20, 25, Tajima further teaches that the scanner apparatus is so implemented as to be capable of operating as a hand scanner in a case where the scanner apparatus is detached from the base unit (Fig.1).

Concerning claims 21, 22, 23, 48-50, Tajima does not teach a lock member locking the scanner apparatus is a stated mounted on the base unit, a stopper preventing the scanner apparatus for swinging excessively frontward of the apparatus in case the scanner is attached to or detached from the base unit, and a deviation preventing the scanner apparatus from displacing upwardly in a case where the scanner is mounted on the base unit. However, it was a matter of old and well known in the art and a matter of design choice to have a lock member locking the scanner apparatus since a lock member and a stopper are well-known to lock any device on a mounting base unit and to stop a device from swinging excessively frontward. Shimizu supports the well known prior art by teaching a hand-held scanner mounted on a base apparatus having an engaging portion to allow the scanner apparatus to rotate frontward while the other is in the form of a holding member or a stopper for holding or stopping the scanner (Fig.3) and a hand scanner removal button 100b to lock the scanner, to prevent the scanner for swinging and to prevent the scanner from displacing upwardly (Fig.3; col. 3, lines 53-57). It would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the art and a matter of design choice to use a lock member to lock the scanner apparatus is a stated mounted on the base unit and a stopper for preventing the scanner apparatus for swinging excessively frontward of the apparatus in case the scanner is attached to or detached from the base unit since Tajima teaches that the scanner part 2 is attachable/detachable fitted on the recessed part 3 while does not limit any supporting mechanism for holding the scanning part 2.

Concerning claim 24, Tajima in view of Shimizu discloses the apparatus discussed in claim 19 above. Tajima further teaches a sheet guide provided on the scanner apparatus and a sheet guide provided on the base unit which are faced each other, and offset member is provided for at least one of the said two sheets guides for stepwise limiting moving of a sheet toward the sheet withdrawing port (Figs.1, 5).

Tajima does not teach that the space between two sheet guides becomes gradually narrower toward a sheet withdrawal port. However, it is a matter of design choice and “old and well known in the art” structure to have any two sheets guide path parallel or not. Shimizu supports the old and well known in the art of 2 sheets guide paths having a space gradually narrower toward a sheet withdrawal port (Fig.4). It would have been obvious to one skilled in the art at the time the invention was made as a matter of design choice to modify the two sheet guide paths having a space gradually narrower toward a sheet withdrawal port as a matter of design choice, supported by Shimizu since both of the designs have the same result for guiding the sheets toward withdrawal ports.

Concerning claim 34, Tajima in view of Shimizu discloses the apparatus discussed in claim 24 above. Tajima further teaches that the base apparatus includes a first sheet guide (3a) provided at a location upstream of the second sheet transporting path (5) and the scanner apparatus includes a second sheet guide provided at a location upstream of the second sheet transporting path (Figs.1, 5).

Concerning claims 35-36, Tajima further teaches that the scanner apparatus includes a pick roller (20) provided at a location upstream of the second sheet transporting path and viewed in a sheet transporting direction and includes a feed roller (21) provided at locations downstream

of the second sheet transporting path and the protecting member is provided at a location outside of a reading area of the scanner apparatus (Figs.5-6).

Concerning claim 47, Tajima further teaches a sheet transporting direction of the sheet transporting path is substantially vertical, and Shimizu further teaches the engaging portion and the scanner mounting portion hold the scanner such that the scanner can rotate about a lower portion (Figs.1, 5).

6. Claims 38-40, 42-45, 52-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu.

Concerning claim 38, Shimizu discloses a multiple function apparatus comprising a base unit; a first transporting guide (100c); a first apparatus (printing unit 4 in the body) provide at a deflecting guide part and performing processing for the first sheet; a second transporting guide (200c), a second apparatus (scanning unit 5) for performing processing of the second sheet wherein the second apparatus is a removable mounted on the base unit and includes a reading element and being implemented as a hand scanner in a case where the scanner apparatus is detached from the base unit wherein a portion of the second transporting guide is movable so that the body including the first apparatus can be exposed.

Shimizu does not teach that the first apparatus can be exposed when the hand scanner is detached from the base unit. However, since the part of the body including the printing unit 4 is exposed, it would have been obvious to one skilled in the art at the time the invention was made to have the printing unit 4 exposed in the upper part or in the lower part of the body as a matter of design choice since the body of the first apparatus can be exposed either way.

Concerning claim 39-40, 42, 44, 45, Shimizu further teaches that the second apparatus is provided opposite of the first transporting guide (claim 39), the directions of transport of the first sheet and second sheet form an angle smaller than 90 degrees (claim 40); the second transporting guide is provided closer to the front side, the first apparatus is an image forming apparatus, the second apparatus is a scanner (claim 42); a portion of the second transporting guide (the scanner) is movable (claim 44); the first apparatus and second apparatus are provided to overlap each other (claim 45).

Concerning claim 43, Shimizu does not directly teach a cover, which is a portion of the second transporting guide to cover the image forming apparatus. However, From Fig.3-4, the mounting portion of the base has a vertical part as a portion of a transporting guide and as a part of a cover. It would have been obvious to one skilled in the art at the time the invention was made to consider the vertical straight part of the apparatus is a cover part of the image forming apparatus since it protect the parts inside the body of the apparatus.

Concerning claims 52, 59, Shimizu teaches an apparatus as discussed in claim 38 above.

Shimizu does not directly teach a cover which is a portion of the second transporting guide to cover the image forming apparatus. However, From Fig.3-4, the mounting portion of the base has a vertical part as a portion of a transporting guide and as a part of a cover. It would have been obvious to one skilled in the art at the time the invention was made to consider the vertical straight part of the apparatus is a cover part of the image forming apparatus since it protect the parts inside the body of the apparatus.

Concerning claims 53-54, Shimizu fails to teach a cover that can be opened and closed or the cover can be removed. However, it a matter of design choice to have such cover since a

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cover, which can be opened and closed or removed, is commonly used for cover any device. It would have been obvious to one skilled in the art at the time the invention was made as a matter of design choice to have a cover which can be opened and closed or the cover can be removed since Shimizu also teaches a cover 100c which can be open or closed or a cover (scanner) which can be removed.

Concerning claims 55-58, Shimizu further teaches that the base apparatus is an image forming apparatus (claim 55); a sheet guide of the image forming apparatus and a sheet guide of the scanner apparatus are provided adjacent to each other (claims 56-57); a sheet feeding portion of the scanner is provide frontward (claim 58).

Concerning claims 60-61, Shimizu further teaches a hand-held scanner, which includes at least one roller for sheet transportation, a center of rotation located at a downstream side.

7. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu as applied to claim 38 above, and further in view of Tajima.

Concerning claim 41, Shimizu further teaches a first transporting mechanism transporting the first sheet from the straight guide part toward the deflecting guide part; a second transporting mechanism transporting the second sheet. Shimizu fails to teach that the direction of the second sheet is in substantially a same direction as the first sheet. However, it is a matter of design choice to have the first and second sheet transports having the same direction. Tajima discloses a system having a detachable scanner mounted on a base unit having two transporting mechanisms wherein the direction of the first and second sheets are in substantially the same direction. It would have been obvious to one skilled in the art at the time the invention was made as a matter

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or design choice to have the first and second sheet direction at the same direction as a matter of design choice supported by Tajima since both ways can transport the sheets to the withdrawing ports.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Stemmler (US Patent No. 5,153,736) discloses a scanner having at least one sheet transport path including at least one index roll on a rotatable shaft to index a sheet through the path.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Tuesday-Thursday 12:30-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2625

October 27, 2006